

Lloyd WOLFINBARGER
Appln. No. 08/646,520

Claim 46, line 1, delete "28, 29,".

REMARKS

Claims 10-18 and 28-49 are pending in the present application. Claims 10-13 have been amended to correct claim dependency. Claim 46 has been amended to change claim dependency so that in claim 46 as amended there is proper antecedent basis for the term "said waste." The Examiner is thanked for conducting an interview with the undersigned on February 2, 1998. No new matter has been added. Reexamination and reconsideration are respectfully requested.

- I. The Examiner is thanked for conducting an interview with the undersigned on February 2, 1998.***
- II At page 3 of the Office Action, claims 10-13, and 46, have been rejected under 35 U.S.C. §112, second paragraph as being indefinite.***

The Examiner states that claims 10-13 improperly depend from claim 50, and that there is no antecedent basis for the term "said waste" appearing in claim 46. Accordingly, claims 10-13 have been amended to properly reflect their dependency on any one of claims "47, 48 or 49," and claim 46 has been amended to make it dependent only on claims that recite the term "waste." In view of the foregoing, the Examiner is respectfully requested to withdraw this objection.

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III. At page 3 of the Office Action, claims 10-15, 17-18, and 47-49, have been rejected under 35 U.S.C. § 102(e) as being anticipated by Morse et. al. ('662).

Responsive to Applicant's previous arguments and filed Declaration, the Examiner states that the Declaration was not persuasive because it did not provide evidence of reduction to practice in that only positive pressure appeared in the notebook page, and because the term "flow" can include "air which can move freely in a stream" and thus '662 disclose a method whereby negative pressure is applied in a vacuum at less than atmospheric pressure to remove bone marrow. In view of the following, this rejection is respectfully traversed.

A. Applicant is Entitled to Rely on his own Definition of "FLOW"

'662 does not teach subjecting the bone to a "**negative pressure-mediated flow**" of solvent. Anticipation requires that a single prior art reference teach each and every element of the claimed invention. The present specification defines a "pressure mediated flow" as "...a flow of solvent induced by positive or negative pressure" and defines "negative pressure" as "...a pressure below atmospheric pressure, i.e., less than one atmosphere." '662 does not teach or suggest subjecting a bone graft to a negative pressure mediated flow of solvent as defined in the present specification. In view of the above it is submitted that '662 does not teach each and every element of the claimed invention as required for anticipation under 35 U.S.C. §102, since '662 does not teach a "pressure mediated flow" of solvent as required by the present claims and as defined in the present specification. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

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B. '662 Does Not Constitute Proper Prior Art

It is submitted that '662 does not constitute proper prior art against the claims of the present invention since '662 is not entitled to rely on the filing date of its parent application U.S. Patent No.:5,333,626 (first filed on December 31, 1991), since none of the material relating to negative or vacuum pressure added in the CIP application ('662) finds support under 35 U.S.C. § 112 in the parent application '626. Accordingly, '662 is only entitled to its filing date of January 21, 1994, as to the newly added material.

Applicant's effective filing date for the present application is the filing date of the first filed application, August 19, 1994 for U.S. Serial No.:293,206, now abandoned which is the parent application of U.S. Patent No.:5,556,379, of which the present application is a division thereof. Filed herewith, please find a Declaration under 37 C.F.R. Rule 1.131(a) establishing Applicant's prior invention. Specifically, the Declaration establishes conception of the present invention on October 1, 1992 (see Exhibit A and the Declaration) and due diligence in reducing the invention to practice which actual reduction to practice occurred no later than March 1, 1993 (see Exhibit B and the Declaration) which date is prior to the filing date of January 21, 1994, of the '662 patent.

In view of the foregoing, the Declaration, and the Exhibits, it is submitted that Morse et. al. '662 does not constitute proper prior art against the claims of the present application.

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In view of the above, it is submitted that the present claims are novel within the meaning of 35 U.S.C. § 102. Accordingly, review, reconsideration and allowance of the present claims are respectfully requested. The Examiner is invited to contact the undersigned at her telephone number on any questions that may arise.

Respectfully submitted,

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Date: March 26, 1958

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